UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,247	05/02/2005	Martin Mosquet	97723.00047	5104

21832 7590 05/30/2008

MCCARTER & ENGLISH LLP
CITYPLACE I
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER	
COHEN, STEFANIE J	

ART UNIT	PAPER NUMBER
4162	

MAIL DATE	DELIVERY MODE
05/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/510,247	MOSQUET ET AL.	
	Examiner	Art Unit	
	STEFANIE COHEN	4162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *May 2, 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/22/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 5 is objected to because of the following informalities: Line 3 of claim 5 recites "CnH2nl" which appears to be a misspelling. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,4,9,12,13,14, 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 7, component b states “and/or” which causes the claim to be indefinite. The examiner interprets that the composition can consist of:

1) component a and component b or

2) component a and component c or

3) component a and component b and component c

Claim 2, lines 2-4, states the paraffin wax consists of alkanes and alkenes by themselves or as a mixture. This contradicts claim 1 which states the paraffin wax consists of these elements as a mixture.

Regarding claim 9, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 12, line 12, states “Q.S to 100% by weight.’ It is suggested to write out the word instead of abbreviate and to add the word "up" between to and 100%.

Claim 13, line 2, states “the sum of the oils”. It is indefinite what oils are being referred to. It is also indefinite what the weight ratio defines.

Claim 4,12,13,14 states a both a narrow and a broad range. This renders the claim indefinite because the boundaries of the claim are not discernible. It is not clear whether the claimed narrower range is a limitation. For purpose of examination, the broader range is considered the range for each claim.

Claim 15, line 1, recites the limitation ""the calculated amount". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C 103 (a) as being unpatentable over Boehme et al. (US 4207115) in view Ando (3669917). Boehme teaches an internal sealant for concrete comprising glyceryl fatty acid ester, stearic or palmitic acid and paraffin wax material. It is known to one of ordinary skill in the art that glyceryl fatty acid ester is formed from a reaction of glycerol, which is a trihydric alcohol, and a fatty acid.

Boehme does not teach physical properties of the paraffin wax. Ando, col. 3 line 18-19, teaches paraffin wax having up to 70 carbons and specifies that a higher n decreases the tendency to volatility during heat treatments. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a wax as taught by Ando in the case of Boehme as the was taught by Ando would remain stable when used during heat application. (See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); Ryco, Inc. v. Ag-Bag Corp., 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988))

Regarding claim 1, lines 1-5, the preamble is considered intended use.

Regarding claim 2, Ando, col. 3 lines, 18-19 teaches paraffin wax having up to 70 carbons which overlaps the carbon range of the instant claims.

Regarding claim 3, as the paraffin wax taught by Ando is commensurate with the instant claims; the melting point would be expected to be commensurate.

Regarding claim 4, it would have been obvious to one of ordinary skill in the art at the time of the invention to optimize the density dependent upon the material used and the desired method of delivery.

Claim 5 is rejected under 35 U.S.C 103 (a) as being unpatentable over Boehme et al. (US 4207115) in view of Ando (3669917) and in further view of Colson (US6297413). Boehme as modified by Ando teaches an internal sealant for concrete comprising a glyceryl fatty acid ester, stearic or palmitic acid and paraffin wax material.

Boehme as modified by Ando does not teach hydrocarbon oil as a component in the composition. Colson, col. 1, lines 40-49, teaches anti- foaming agents comprising an alcohol alkoxylate and paraffinic oil. Colson also teaches paraffinic oils can "significantly destabilize foam" and the "time taken to break the foam with the paraffinic oils is significantly shorter than that found for conventional antifoam agents and for diesel oil". Paraffinic oil is synonymous for hydrocarbon oil. It would be obvious to combine the hydrocarbon oil of Colson with the paraffin wax and ester of Boehme. As taught by Colson, the hydrocarbon oil reduces the foam and therefore would increase the effectiveness of water retention on the surface of concrete and/or mortar. The paraffinic oil used in Colson, col.2, line 59, "contains one or more paraffins having 9 to 14 carbon atoms". While Colson does not teach the exact same carbon atom range as recited in the instant claims, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the carbon atom range taught by Colson overlaps the instantly claimed range.

Claims 6 -16 are rejected under 35 U.S.C 103 (a) as being unpatentable over Boehme et al. (US 4207115) in view Ando (3669917), in view of Colson (US6297413) and in further view of Kuroda (4741773). Boehme as modified by Ando and Colson teaches an internal sealant for concrete comprising a glyceryl fatty acid ester, stearic or palmitic acid, paraffin wax material and hydrocarbon oil, but does not teach the physical properties of the hydrocarbon oil. Kuroda teaches the physical properties of the hydrocarbon oil. Kuroda teaches a water repellant composition comprising silicone oil

and substantially non -volatile paraffinic oil where substantially non -volatile paraffinic oil. Substantially non- volatile paraffinic oil means that when the water repellant composition is applied to an object the paraffinic oil will remain without evaporation for a long period of time. Regarding claims 6 and 7, it would have been obvious to one of ordinary skill in the art to use a non volatile paraffinic oil as taught by Kuroda as it is non-volatile and will remain without evaporation for the purpose of water repellency. Furthermore, it would have been obvious to optimize the kinematic viscosity and density dependent upon the material used and the desired method of delivery.

Regarding claim 8-11, Boehme et al. (US 4207115), column 2 lines 29-31, teaches a fatty acid ester "results from the esterification of a trihydroxy alcohol with such complex acids as palmitic, stearic and oleic acid".

Regarding claims 10 and 11, Boehme teaches a glycerol which has 3 carbons and falls within the carbon range recited of the instant claims.

Regarding claim 12, Boehme teaches a composition comprising 20% hydrogenated tallow and 75% paraffin wax by weight which falls within the weight percent range recited in the instant claims. Tallow is considered fatty acid-esters.

Regarding claim 13, the weight ratio of dry active matter of the sums of the oils and of the paraffin wax is .266 when considering weight percentages of claim 12.

Regarding claim 14, as the components are similar and the weight ratios overlap, the dry matter content would also expected to overlap.

Regarding claim 15, Boehme, col. 2 line 55-57, teaches STP beads which comprise the tallow and paraffin wax are manufactured by mixing and heating and cooling the blended materials. It would have been obvious to one of ordinary skill in the art that the components would not have to be mixed in a specific order to achieve the necessary water retention in concrete.

Regarding claim 16, it would have been obvious to one of ordinary skill in the art to optimize the weight deposited per area of the aqueous emulsions to achieve the necessary water retention in concrete.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefanie Cohen whose telephone number is 571-270-5836. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefanie Cohen

April 23, 2008

/Jennifer McNeil/
Supervisory Patent Examiner, Art Unit 4162